

REMARKS

Claims 1-8, 10-22, 24-36, and 39-41 are pending. No claim has been amended.

In the Official Action, claims 1-36 and 39-41 stand rejected as allegedly being obvious over the combined teachings of Boyd (US 2002/019404) and Hanson et al. (US 6,691,153). This rejection is respectfully traversed.

In the previous amendment response, Applicant noted Examiner Mirza's indication during a personal interview with Applicant's undersigned representative that he would withdraw his rejection of claims 29-36 and 39-41 over Boyd and Hanson et al. and would withdraw his rejection of claims 1-28 over Boyd and Hanson et al. if claim 1 were amended to include the limitations of claim 9 and claim 15 were amended to include the limitations of claim 23. Though Applicant amended claims 1 and 15 as proposed by Examiner Mirza, Examiner Mirza has again rejected claims 1-36 and 39-41 over the teachings of Boyd and Hanson et al. Such a rejection is believed to have been overcome for the reasons noted during the personal interview and agreed upon by Examiner Mirza. Withdrawal of the rejection of claims 1-36 and 39-41 is again requested.

In the text accompanying the rejection of claims 1-36 and 39-41, Examiner Mirza acknowledges (page 4 of the June 23, 2005 Official Action) that Boyd and Hanson et al. together do not disclose the claimed feature: "each one of the compatibility indicator sets including a friendship indicator and a relationship indicator associated with a corresponding one of the chat participants." Though not made part of the rejection of the claims, the Examiner references the teachings of Olivier in USP 6,480,885 as providing a "two-way match process" that could have been used in a Boyd-Hanson et al. system to calculate the degree to which each other subscriber's profile data meets the subscriber's user profile acceptance criteria data. Examiner Mirza then concludes that such calculations may be combined into one summary calculation as taught by Olivier to "provide high quality interactions within electronic forms."

Though not formally made a part of the rejection of the claims, Applicant will assume that the previous rejection of claims 1-36 and 39-41 has been modified to include the combined teachings of Boyd, Hanson et al. and Olivier. Applicant strongly disagrees with the Examiner's interpretation of the prior art. As will be explained below, none of the cited

prior art, taken alone or together with other cited prior art, teaches or suggests the claimed features: "each one of the compatibility indicator sets including a friendship indicator and a relationship indicator associated with a corresponding one of the chat participants" as set forth in claims 1-28, the selection of compatible chat rooms as set forth in claims 29-36 and 40, or a virtual date software element as claimed in claims 39 and 41. Moreover, absent hindsight, there is absolutely no reason offered by Examiner Mirza to combine the cited references to arrive at the claimed invention. Accordingly, the rejection of claims 1-36 and 39-41 is respectfully traversed for failure to establish a *prima facie* case of obviousness.

As noted in a previous response, in order to establish a *prima facie* case of obviousness, patent examiners are required to establish three criteria: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art reference, or combination of references, must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); M.P.E.P. §§ 2143 - 2143.03. To make a proper obviousness determination, the patent examiner must "step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made." M.P.E.P. § 2142. In view of the available factual information, the patent examiner must make a determination as to whether the claimed invention "as a whole" would have been obvious at that time to that person skilled in the art. Importantly, a rejection based on these criteria must be based on what is taught in the prior art, not the applicant's disclosure. The applicant's disclosure may not be used as a blueprint from which to construct an obviousness rejection. *Interconnect Planning Corporation v. Feil*, 774 F.2d 1132, 1138 (Fed. Cir. 1985); *Orthopedic Equipment Company v. United States*, 702 F.2d 1005, 1012 (Fed. Cir. 1983); *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 297 (Fed. Cir. 1985); *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996). The patent examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. The Examiner still has not met this burden in this case.

First, there is no reason in the cited references and no suggestion or motivation provided by the Examiner to combine the teachings of the cited references. The Examiner merely alleges that Boyd, Hanson et al. and Olivier are "from the same field of endeavor" and

that it would have been obvious to one skilled in the art to incorporate the image server of Hanson et al in the web server of Boyd. Applicant can find no suggestion or motivation for this combination and the Examiner has provided none. Similarly, the Examiner alleges that it would have been obvious to have incorporated the "two-way match" taught by Olivier into the "method of Boyd-Hanson-Olivier to provide high quality interactions within electronic forms." Again, Applicant can find no suggestion or motivation for this combination and the Examiner has again provided none.

Second, even if the Examiner could find a motivation for the combination, the combination falls far short of suggesting the claimed invention. None of the cited references discloses a chat environment including "an area for chat messages, a plurality of screen images, each one of the plurality of screen images associated with a corresponding one of the chat participants, and a plurality of compatibility indicator sets, each one of the compatibility indicator sets including a friendship indicator and a relationship indicator associated with a corresponding one of the chat participants" as claimed. The Examiner has acknowledged as much with respect to Boyd and Hanson et al.

As previously noted, Boyd teaches a network service where users may post notices for a meeting at a particular place and time and receive responses via email, phone, beeper, and the like accepting the meeting. The invitations may be categorized by criteria (paragraphs [0049] and [0055] on page 5) to facilitate searching by those interested in responding. A person reviewing invitations may check the personal pages in a profile database of the persons posting meeting notices before accepting. The system may account for user interests (paragraph [0061] on page 6) and personality traits (paragraph [0065] on page 6) in a static manner but specifically disclaims the notion that the system may be used as a "dating service" (paragraph [0067] on page 6). Nothing in the Boyd disclosure suggests the system includes a chat service, particularly one that identifies the compatibility of other chat participants.

The teachings of Hanson are not particularly relevant either. Hanson teaches providing a "dynamic content region" in an electronic medium so that changing (dynamic) content may be incorporated into a "process interaction." Nothing in the Hanson patent suggests the system includes a chat service, particularly one that identifies the compatibility of other chat participants.

Contrary to the Examiner's allegations in the Official Action, the teachings of Olivier do not bridge these shortcomings in the teachings of Boyd and Hanson et al. Olivier teaches a system for dynamically matching users for of exchange group electronic mail by establishing individual profiles and criteria for determining personalized subsets within the electronic mail group. Users establish subscriptions to an electronic mailing list for the exchange group electronic mail by specifying user profile data and acceptance criteria to screen other users. The users may apply one-way or mutual criteria matching and message profile criteria to other group forums such as, *inter alia*, chat environments.

While Olivier suggests application of a two-way system in a chat environment, Olivier provides no teachings of providing compatibility indicator sets including a "friendship indicator" and a "relationship indicator" associated with each chat participant as claimed in independent claims 1 and 15. In particular, Olivier does not teach or suggest a chat environment with an interface such as that in Figure 19 whereby a "friendship indicator" and "relationship indicator" for each chat participant relative to the user is provided to facilitate the user's chatting. Olivier also provides no teachings of selecting a chat channel based on compatibility values of the other chat participants as described with respect to Figures 16-18 and claimed in independent claims 29, 33 and 40. Finally, Olivier provides no teachings relevant to the virtual date software element described with respect to Figures 19g-19k and set forth in independent claims 39 and 41. Accordingly, even if the teachings of Olivier could have been combined with the teachings of Boyd and Hanson et al. (for which there is no such teaching or suggestion), the claimed invention would not result.

In view of the above, Applicant submits that the Examiner has not established *prima facie* obviousness because there is no suggestion or motivation to combine the teachings of the references and because the references separately or together do not teach a chat service that identifies the compatibility of other chat participants using a "friendship indicator" and a "relationship indicator" as claimed. Also, Boyd specifically teaches that his invention is NOT for a dating service and thus specifically teaches away from the claimed invention. In view of these shortcomings in the obviousness rejection, withdrawal of the rejection of claims 1-8, 10-22, 24-36 and 39-41 is requested.

If the Examiner maintains the rejection over Boyd, Hanson et al., and Olivier, he is strongly encouraged to indicate where he believes the references alone or together teach the

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claimed chat environment with "friendship indicator" and "relationship indicator" as claimed. Applicant submits that mutual matching simply does not suggest to one skilled in the art the advancements in a chat room environment made in accordance with the claimed invention.

Conclusion

For the foregoing reasons, Applicant respectfully requests reconsideration and allowance of claims 1-8, 10-22, 24-36 and 39-41 and issuance of a Notice of Allowability.

Date: Monday, October 24, 2005

A handwritten signature in cursive script that reads "Michael P. Dunnam".

Michael P. Dunnam
Registration No. 32,611

Woodcock Washburn LLP
One Liberty Place - 46th Floor
Philadelphia PA 19103
Telephone: (215) 568-3100
Facsimile: (215) 568-3439